

In re: Asplin
Serial No.: 09/687,445

REMARKS

This amendment follows the outstanding Official Action dated 12/19/01 and is intended as a complete and proper response thereto. In particular, the present paper is presented with the view of advancing prosecution of this application on its merits and hopefully placing this case in a clear condition for allowance.

In order to render this Amendment responsive, a Petition for Extension of Time to Respond Within the Third Month Pursuant to § 1.136(a) is submitted herewith in duplicate along with the requisite petition fee of \$460.00 commensurate with the applicant's small entity status as previously established.

Claims 7-16 as originally filed remain in the application. Claims 7 and 12 have been extensively amended in accordance with the examiners detailed action. Further, new claims 17-21 have been added. As such, reexamination and reconsideration of the application, as amended, is requested.

Claim 7 was initially rejected under 35 U.S.C. § 103(a) as being unpatentable over Wildon 5,558,474 in view of Poulter 2,074,756 and Casella 5,974,611. For prior art references to be combined to render obvious a subsequent invention under § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434,

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1438(Fed. Cir. 1988). The teaching of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599(Fed. Cir. 1988). Hindsight is forbidden. It is impermissible to use the claims as a framework from which to pick and choose individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Wildon 5,558,474 patent generally discloses a sand blasting apparatus. Applicant concedes that it is known in sand blasting apparatus' to mix air and sand for cleaning and blasting metal materials. The Poulter 2,074,756 patent generally discloses an apparatus for mud pumping as described in the current application. These type of apparatus' generally use a hole drilled in the concrete to pump mud under pressure under the concrete and have the problems associated therewith as described in the current application. Finally, the Casella 5,974,611 patent generally discloses an interlocking multi-purpose air tool for use with various attachments including attachments to launch pellets for cleaning or purging tubes and pipes. The examiner has used this application as, at one point, this application shows that a pressure relief valve may be used with the interlocking multi-purpose air tool.

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As can be seen from the above amendments, claim 7 as originally presented has been amended to further include the limitations regarding the nozzle on the air gun. It is believed that this limitation is not shown anywhere in the prior art. However, having stated this, it is also believed that no where in the prior art of Casella disclosing an interlocking multi-purpose air tool, Poulter disclosing a mud pumping apparatus and Wildon disclosing a sand blasting apparatus is there any teaching or incentive to combine these three completely unrelated patents to come up with the invention as is currently claimed. As such, it is believed that under the case law, the rejection under §103(a) is impermissible and has been traversed based on the above amendment and discussion.

Further, claims 8-11 have also been rejected as being unpatentable over Wildon in view of Poulter, Casella and further in view of Carey-Yard 4,850,752. Once again, another piece of prior art, specifically Carey-Yard, discloses the use of air to blow rocks under voids. Again, there is no incentive in any of these four pieces of prior art to combine them to come up with the invention as shown. Further, in light of the above amendment, it is believed that this rejection has also been traversed.

Claim 12 as originally presented has been found unpatentable over Poulter in view of Wildon. As can be seen, claim 12 as now presented includes the limitation of using the air to actually raise the slab to create a void to blow sand into it. Nowhere in Poulter or Wildon is there any teaching or incentive to do this,

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nor is this limitation disclosed by any of the prior art of record. As such, it is believed that in light of the amendment, claim 12 and it's remaining dependent claims 13-16 are now patentable over the prior art of record. Further, in review of both Poulter and Wildon, there is no teaching or incentive to combine mud pumping with sand blasting to come up with the invention as claimed in claim 12. As can be seen from a review of Poulter, Poulter uses liquid under pressure in order to raise the concrete and, as discussed in the application, this liquid often requires the slab to be raised to a higher level as the liquid dissipates and evaporates over time allowing the cement to settle. The current application teaches the use of dry sand which avoids these problems. The Wildon patent for a sand blaster does not disclose or teach any form of use of the sand blasting material in order to raise slabs but rather is aimed towards cleaning, metals, walls, etc. of rust, paint and other materials.

Finally, claims 17-21 have been added and also include the limitation of using the air pressure to raise the slab for placement of the dried sand.

In light of the above amendments and detailed discussion of the prior art of record, including the discussion of the examiners initial §103 rejections, these rejections have been traversed. As such, it is believed that the patentable nature of the claims has been demonstrated.

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In view of the above remarks, reconsideration and allowance of the claims is kindly requested. Should any matters remain outstanding that may be handled over the phone the examiner is encouraged to call.

Respectfully Submitted,

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